

REMARKS

Claims 6-9, 12, 14 and 16-21 remain pending in the application. Reconsideration is requested.

REJECTION UNDER 35 U.S.C. § 103

Claims 6-9, 12, 14 and 16-24 were rejected under 35 U S C §103 as being unpatentable in view of U.S. Patent No. 6,351,640 (DeMont) and U.S. Patent No. 6,532,372 (Hwang). This rejection is respectfully traversed for the reasons explained below. Applicant's arguments presented below focus on certain patentable differences between the invention as claimed and the applied references. However, it is not to be inferred that the failure to argue all differences between the claimed subject matter and the applied references constitutes acceptance of assertions made in the Office Action of alleged similarities between elements of the claimed subject matter and the applied references.

Independent method claim 6 is directed to initiating a phone call between first and second users. A call initiation request is sent from the first user representing a desire to establish a phone call with a specific second user. The call initiation request includes the primary phone number corresponding to the first user. The primary phone number is not obtained as part of an incoming phone call initiated by the first user. This primary phone number is stored in computer readable memory associated with a communication device of the second user. A request is made of the second user for authorization to initiate the call by which the second user must consent to the call. The primary phone number is dialed if the authorization from the second user is received. The phone number is automatically deleted from memory.

In the Office Action, DeMont was relied upon for supplying the required teachings of claim 6 except for the requirement of storing the primary phone number in memory for which Hwang was relied upon. Thus, only Hwang is relied upon, and hence only Hwang need be considered, for providing teachings regarding storing and/or deleting the phone number in computer memory. It was acknowledged in the Office Action that DeMont did not teach storing the

primary phone number to a computer readable memory. Hwang in combination with DeMont does not teach or render obvious these requirements of claim 6.

Column 2, lines 17-21 of Hwang was cited for teaching the storing of a primary phone number to a computer readable memory. Hwang is directed to an environment in which a PC is supported by wireless communications through a mobile phone. The objective of Hwang is to provide the mobile phone with a mechanism for detecting a lack of data communications between the mobile phone and the PC so that the wireless connection between the mobile phone and a remote data source can be disconnected to prevent unnecessary charges to the user.

The relied upon text of Hwang states: "A nonvolatile memory 214, which is provided to store phone numbers for shortcut dialing, and may include system parameters, may be an electronically erasable programmable read-only memory (EEPROM)."

With regard to deleting a phone number, it is stated in the Office Action, "the memory is an EEPROM, which can be erased when the user desires." However, Hwang provides no teaching or suggestion with regard to the automatic deletion of a phone number that may have been stored in memory.

MPEP §706.02(j) states: "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." Emphasis added.

Hwang provides no teaching with regard to the deleting of phone numbers that may be stored in the EEPROM memory. And Hwang certainly provides no teaching concerning an "automatic

deletion of phone numbers".

There is nothing inherent about an EEPROM memory that would lead one of ordinary skill in the art to assume that information stored in the memory would be automatically deleted.

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) MPEP 2112. Emphasis added. The possibility that a phone number might have been deleted from the EEPROM of Hwang is clearly not sufficient grounds to support a rejection; see above requirement. Therefore, even considering the combination of Hwang with DeMont, prima facie grounds are not provided to support a rejection under 35 U.S.C. 103.

Independent claim 14 is not rendered obvious in view of the applied references for similar reasons explained above with regard to claim 6.

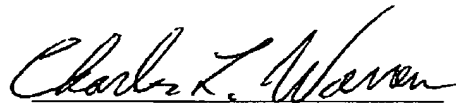
Claim 8 (and similar claim 19) further recites that the step of deleting the primary phone number from the computer readable memory comprises deleting the primary phone number automatically upon receipt of the authorization from the second user to initiate the call. As explained above, Hwang cannot be fairly interpreted as teaching the deletion of phone number stored in memory. Claim 8 further patently distinguishes by defining that the phone numbers are automatically deleted from memory upon receipt of authorization from the second user to initiate the call. No such teaching is found in Hwang or DeMont. Therefore, claims 8 and 19 clearly distinguish over the applied references and the rejection under 35 U.S.C. 103 should be withdrawn.

Claim 12 (and similar claim 20) further recites deleting the stored phone number automatically upon receipt of a denial of authorization from the second user to initiate the call. Hwang does not teach the deletion of phone numbers from memory, and more specifically, does not teach the

automatic deletion of such phone numbers upon receipt of a denial of authorization from the user to make a call. Therefore, neither Hwang, DeMont, nor the combination thereof, renders the subject matter of claims 12 and 20 obvious.

Applicant respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned.

Respectfully submitted,



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